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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/302,552      | 04/30/1999  | STEPHEN SAVITZKY     | 15358-46            | 7040             |

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PFA

|                              |                             |                  |
|------------------------------|-----------------------------|------------------|
| <b>Office Action Summary</b> | Application No.             | Applicant(s)     |
|                              | 09/302,552                  | SAVITZKY ET AL.  |
|                              | Examiner<br>Maikhanh Nguyen | Art Unit<br>2176 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 April 1999.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_

***DETAILED ACTION***

1. This action is responsive to communications: original application filed 04/30/1999.
2. Claims 1-9 are currently pending in this application. Claims 1 and 9 are independent claims.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 recite the limitations:

- “the stack object” (claim 1, line 5)
- “the stack object” (claim 9, line 5)

There are insufficient antecedent basis for these limitations in the claims.

Dependent claims 2-8 are rejected for fully incorporating the deficiencies of their base claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wang et al.** (U.S. 5,237,679 – filed 05/1990) in view of **Schmid et al.** (U.S. 5,569,164 – filed 10/1996).

**As to independent claim 1**, Wang teaches in an electronic document handling system, a method of associating documents (it is now possible to electronically group multiple documents together in a manner which is analogous with paper office techniques; col.1, line 55 – col.2, line 12), comprising the steps of:

- generating a staple data object, for representing an association of selected pages and selected documents (a temporary stapler document relationship may be created by stapling a first document to a second document; col.2, lines 35-56);
- generating an electronic cover sheet for a stack object (a temporary electronically designated folder; Abstract).

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- accepting from a user a list of at least one page of at least one electronic document

(document relation object 48 is utilized to describe the logical relationships between the present document and other documents; col.4, lines 52-68);

- accepting a staple instruction from a user (document is stapled to another document; col.4, lines 52-68); and

- cryptographically securing the staple data object in response to receipt of the staple instruction (access control model object 44... contains access control information... identify those users or groups of users to whom some form of access authority to the document has been granted; col.4, lines 37-44).

However, Wang does not explicitly teach:

- generating an electronic cover sheet; and

- referencing each page or each electronic document in the list as an item of the stack

object .

Schmid suggests:

- generating an electronic cover sheet (associated pages of a single document can be visually identified and electronically “stapled” or assembled together with appropriate software ...a cover page which contains both machine and human-readable information col.1, line 45 – col.2, line 44); and

- referencing each page or each electronic document in the list as an item of the stack object (associated pages of a single document can be visually identified and electronically “stapled” or assembled together; col.1, lines 40-50).

It would have been obvious to a person of ordinary skill in the art of the time of the invention was made to combine the teachings of Schmid with Wang because it would have provided the capability for organizing groups of documents when performing electronic stapling.

**As to dependent claim 2**, Wang teaches accepting a manually input list (col.4, lines 52-68).

**As to dependent claim 3**, Wang teaches accepting a computer-generated list (col.4, lines 52-68).

**As to dependent claim 4**, Wang teaches presenting a user with an online form as an aid to selecting pages or documents for association as a stack (col.5, lines 9-51).

**As to dependent claim 5**, Wang teaches a step of prompting for the staple instruction by presenting the user with a stapler icon which, when selected, represents the staple instruction (col.4, lines 52-68).

**As to dependent claim 6**, Wang teaches a step of copying the selected pages and selected documents in a stack to static storage (col.5, lines 9-34).

**As to dependent claim 7**, Wang teaches a step of copying the selected pages and selected documents in a stack to a local storage device local to the electronic document handling system (col.5, lines 9-34).

**As to dependent claim 8**, Wang teaches (col. 6, lines 12-58) displaying a first list of documents, wherein the first list of documents lists the documents that are selected for inclusion in an open stack ; displaying a second list of document, wherein the second list of documents list documents that have not been selected for inclusion in an open stack; and displaying a user

interface control operative to obtain selections from a user of documents from the second list for inclusion in an open stack..

**As to independent claim 9,** the rejection of independent claim 1 above is incorporated herein in full. However, claim 9 further recites:

- opening a secured stack upon receipt of a stack open instruction;
- presenting the contents of the secured stack for perusal by the user;
- accepting additions and deletions of items on the secured stack; and

securing the secure stack upon receipt of a stack restaple operation.

Wang teaches:

- opening a secured stack upon receipt of a stack open instruction; presenting the contents of the secured stack for perusal by the user (a review of the document relation object 48 of FIG. 2 indicates that the document to be deleted forms a portion of a relationship with another document; col.5, lines 57-66);

- accepting additions and deletions of items on the secured stack (reverse search index object 58...support the removal of search index entries...the addition or deletion of data objects; col. 5, lines 19-34); and

- securing the secure stack upon receipt of a stack restaple operation (access control model object 44... contains access control information... identify those users or groups of users to whom some form of access authority to the document has been granted; col.4, lines 37-44).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

|             |                          |                             |
|-------------|--------------------------|-----------------------------|
| Ogino       | U.S Patent No. 5,771,103 | issued dated: Jun. 23, 1998 |
| Ahn         | U.S Patent No. 5,848,409 | issued dated: Dec. 8, 1998  |
| Cukor et a. | U.S Patent No. 5,168,444 | issued dated: Dec. 1, 1992  |

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhahan Nguyen whose telephone number is (703) 306-0092.

The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

**Contact Information:**

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or fax to:**

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.  
OFFICIAL faxes must be signed and sent to (703) 746-7239.

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NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen

May 1, 2002

  
HEATHER R. HERNDON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTO-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.